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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/773,684 | 02/06/2004 | Paul A. Lotke | 4323-P03363US0 | 7807 |

110 7590 08/18/2005

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

SNOW, BRUCE EDWARD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3738

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/773,684

Applicant(s)

LOTKE, PAUL A.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 26-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 14-22 and 25 is/are rejected.
- 7) ☒ Claim(s) 4, 8-13, 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>May 21, 04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-25, in the reply filed on 6/20/05 is acknowledged. Applicant's traversal is not found persuasive. Regarding the first proposed materially different process of using the product, the product of claim 1 includes first and second wings not required in the method of claim 26. According to applicant's arguments regarding the second proposed process, a portion of bone would or at least could be resected for the wings. Clearly the product could be used in a method of providing first and/or second wings. Regarding the second proposed process, the Examiner disagrees, bone does not have to be resected. The implant simply replaces worn and/or missing bone. Regarding the proposed third process, where the device is used as a teaching device, such as to teach surgeons to use correctly or for sales purposes, applicant argues that the methods claims (second invention) do not burden the Examiner. The Examiner believes the method is patentable distinct for the product; prosecuting two inventions in an application is a burden. Additionally, see the reasoning in the Restriction requirement for the distinction between the groups.

The requirement is still deemed proper and is therefore made FINAL.

Allowable Subject Matter

Claims 4, 8-13 and 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-7, 14-22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Merchant (6,616,696).

Merchant teaches two embodiments of a femoral prosthesis; the first embodiment 186 including all limitations of claim 1:

a femoral prosthesis configured to cover a portion of the distal end of a femur, comprising:

a saddle-shaped trochlear groove portion comprising:

a central convexly-shaped groove extended toward a distal end of the femoral prosthesis;

a convexly-shaped medial portion extending upwardly away from a first side of the central groove;

and a convexly-shaped lateral portion extending upwardly away from a second side of the central groove; and

an intercondylar notch portion intersecting the trochlear groove portion, comprising

a first wing extending distally and curving posteriorly from the distal end of the medial portion;

and

a second wing extending distally and curving posteriorly from the distal end of the lateral portion and curving away from the first wing; and

a patellar prosthesis 112, 184, 190 configured to cover a posterior portion of a patella,

comprising a first surface configured to be attached to a patella, and a second surface configured to cooperate with the trochlear groove and intercondylar notch portions of the femoral prosthesis to facilitate sliding engagement between the femoral prosthesis and the patella prosthesis.

Regarding the "edge" limitations, the medial and lateral extensions inherently have an inner edge separated by a generally rectangular box region. The extensions do not extend over the intercondylar notch, the box region connecting the extensions does. See attachment 1. Applicant is reminded of their use of the transitory phrase "comprising" which can include other limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 14-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saleh (3,816,855).

Saleh teaches a knee prosthesis for covering a portion of a patient's patella, and trochlear groove and intercondylar notch of the femur, comprising:

a femoral prosthesis comprising a body 13 having a posterior surface configured to cover a portion of the trochlear groove and an anterior surface forming a groove that is cooperable with the posterior surface of a patellar prosthesis; and

a medial extension 11 projecting away from a distal end of the body configured to extend along a medial edge of the intercondylar notch; and

a lateral extension 12 projecting away from a distal end of the body configured to extend along a lateral edge of the intercondylar notch.

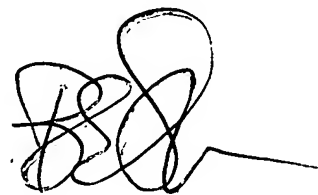
However, Saleh fails to teach a patellar implant. It would have been obvious to one having ordinary skill in the art to have utilized a patellar implant (112 etc.) of Merchant with the femoral prosthesis of Saleh wherein the articulating surface of the patella is damaged.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes

A handwritten signature in black ink, appearing to be 'BSN' followed by a stylized flourish.

BRUCE SNOW
PRIMARY EXAMINER

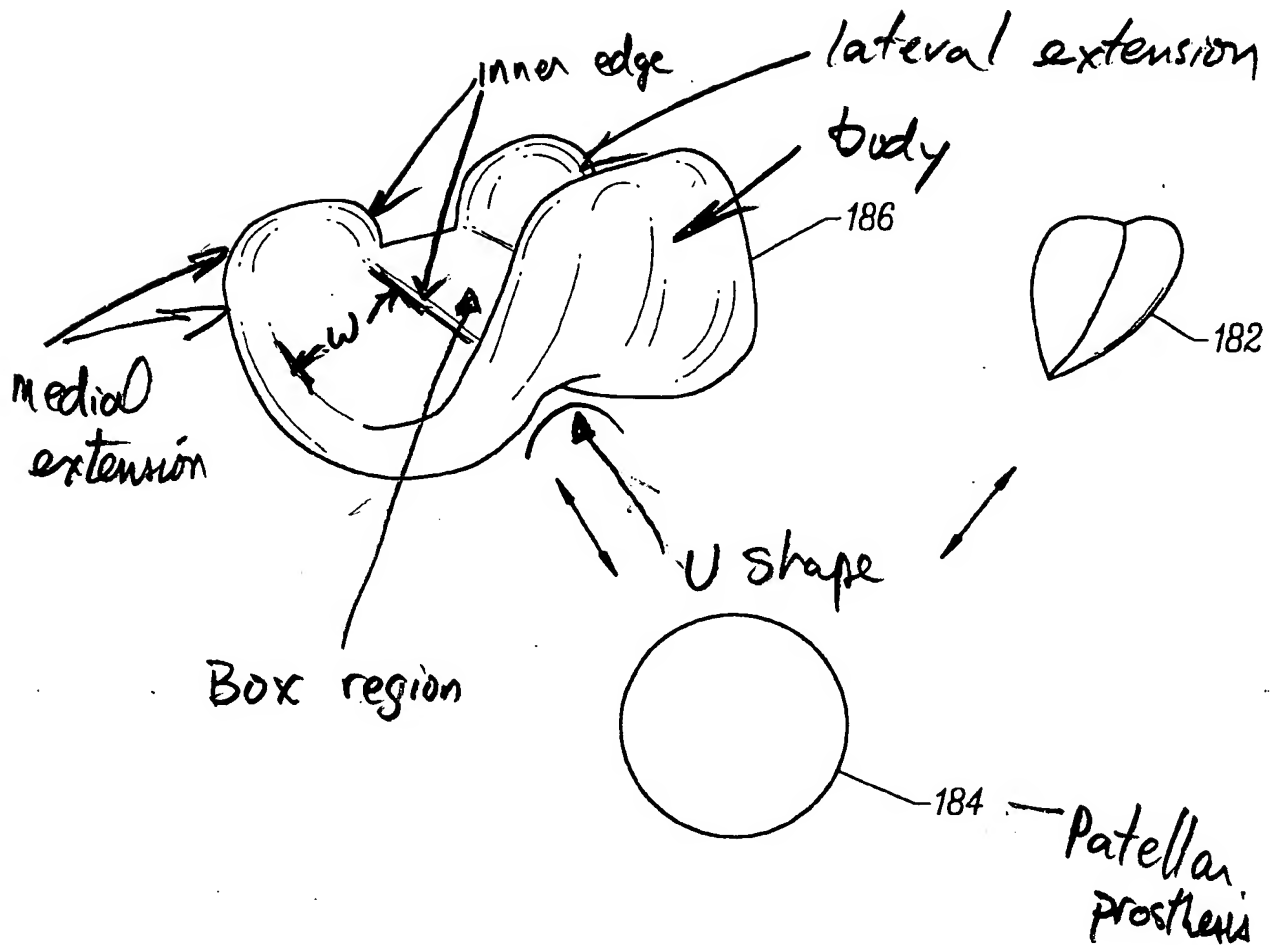


FIG. 13